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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/913,378  | 11/02/2001  | Guido Baumoeeller    | H-3954-PCT/U        | 9714             |
| 23657   | 7590        | 08/10/2004           | EXAMINER            |                  |
| COGNIS CORPORATION<br>PATENT DEPARTMENT<br>300 BROOKSIDE AVENUE<br>AMBLER, PA 19002 |             |                      | CHIN, PETER         |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1731                |                  |

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/913,378  
Filing Date: November 02, 2001  
Appellant(s): BAUMOELLER ET AL.

\_\_\_\_\_  
Steven J. Trzaska  
For Appellant

**EXAMINER'S ANSWER**

**MAILED**  
**AUG 10 2004**  
**GROUP 1700**

This is in response to the appeal brief filed May17, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 10-23 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

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The copy of the appealed claims contained in the Appendix to the brief is correct.(9)

***Prior Art of Record***

6,207,014

de Haut et al

3-2001

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 10-23 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over de Haut et al (6,207,014).

de Haut et al discloses impregnating paper with an aqueous softening lotion.

The lotion contains the following components (last paragraph of column 5):

- a) 35-95% fatty alcohol
- b) 1-50% waxy esters having a total of 24-48 carbon atoms
- c) up to 20% nonionic/amphoteric emulsifiers
- d) up to 50% mineral oil or wax.

The waxy esters are listed in column 2, lines 27-32 and include the ones recited in present claim 13. The preferred amount of emulsifier is 1.5 –5%, wax is 1-10% see column 8, lines 50-65.

One of the preferred non-ionic polyol emulsifier is in particular polyglycerol poly-12-hydroxystearate, column 7, lines 60-62.

The claims by virtue of the “comprising” and “containing” language is open to the presence of the fatty alcohol of de Haut et al's composition. Thus, the present claims

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read on and thereby anticipated by the composition of de Haut et al's lotion. At the very least, it would have been obvious to select those components and amounts which de Haut et al considered to be preferred over other listed components. Therefore one of ordinary skill in the art would have selected the preferred amount of wax and the polyglycerol poly-12-hydroxystearate the non-ionic emulsifier.

**(11) *Response to Argument***

Appellant's arguments are premised on de Haut et al's broad disclosure of such a multiplicity or multitude of choices for each of the components of the lotion that de Haut et al cannot anticipate the claimed invention. It is further argued there is also no guide as to the selection of one member of a component over others. The fact is that the selection is based on members of component that de Haut et al considered preferred over others and does require undue experimentation or speculation as implied by Appellant's arguments.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

  
Peter Chin

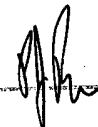
Primary Examiner  
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August 5, 2004

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